

**REMARKS**

Claims 1, 8, 9, 11, 12 and 14-21 are pending in this application. By this Amendment, claims 1, 8, 9, 11, 12, 14 and 17 are amended, and claims 2-7, 10 and 13 are canceled without prejudice to or disclaimer of the subject matter set forth therein. Support for the amendments to claims 1, 8, 9, 11, 12, 14 and 17 can be found in the specification as originally filed, for example, at paragraphs [0012] and [0013], and in original claims 1-14 and 17. No new matter is added by these amendments.

Applicant appreciates the courtesies shown to Applicant's representative by Examiner Goodrow in the February 1 personal interview. Applicant's separate record of the substance of the interview is incorporated into the following remarks.

**I. Rejections Under 35 U.S.C. §112**

**A. First Paragraph**

The Office Action rejects claims 1 and 2 under 35 U.S.C. §112, first paragraph, as failing to comply with the enablement requirement. In particular, the Office Action asserts that claims 1 and 2 are not enabled by the specification because independent claim 1 recites "at least one thermally cross-linkable polymer resin," and all polymers can generally be described as either thermoplastic or thermosetting. While Applicant does not necessarily agree that original claims 1 and 2 (which depends from claim 1) are not enabled, independent claims 1 and 17 are amended to claim specific types of thermosetting polymer resins as the thermally cross-linkable polymer resin. Accordingly, Applicant respectfully requests reconsideration and withdrawal of this rejection.

**B. Second Paragraph**

**1. Claim 12**

The Office Action rejects claim 12 under 35 U.S.C. §112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter that

Applicant regards as the invention. In particular, the Office Action takes the position that the toner composition of claim 1 is limited by claim 12 to comprising one additive, which should be chosen from those disclosed in the specification. In the interests of furthering prosecution, Applicant amends claim 12 herein to set forth that the toner composition of claim 1 further comprises at least one additive and to set forth a group of additives from which the at least one additive may be chosen. However, Applicants respectfully submit that the claims do not exclude toner compositions including more than one additive, as is evident from the open-ended "comprises" language as well as from the phrase "at least one." Thus, Applicant respectfully requests reconsideration and withdrawal of the rejection.

## **2. Other Issues**

During the February 1 personal interview, the Examiner indicated that the phrases "toner composition" and "thermally cross-linkable" could be considered unclear. Applicant respectfully submits that these phrases are clear and understandable by those of ordinary skill.

With respect to the phrase "toner composition," the Examiner indicated that this phrase could be considered indefinite because it is unclear whether "toner composition" refers to the toner "in the pot" (during toner preparation) or to the toner particles themselves. The Examiner took the position that no cross-linking agent would be present in the toner after cross-linking. Applicant respectfully submits that "toner composition," in this application, includes both "in the pot" and toner particles. Specifically, Applicant directs the Examiner to the specification, which discloses that functionalities are maintained in the toner particles and interact to cross-link the resins during fusing. *See* Specification, [0015], [0016]. In light of these teachings, Applicant respectfully submits that the phrase "toner composition" is not indefinite.

With respect to the phrase "thermally cross-linkable," the Examiner indicated that it is unclear what is meant by this term. However, Applicant respectfully submits that the phrase "thermally cross-linkable" clearly indicates that the polymer resins under discussion can react to form cross-linked structures upon the application of heat. That is, the phrase "thermally cross-linkable" means that, when heated, the polymer resins will react to form linkages. Thus, Applicant respectfully submits that this phrase is clear on its face.

## **II. Claim Rejections Under 35 U.S.C. §102/§103**

The Office Action rejects claims 1-21 under 35 U.S.C. §102(a) or, in the alternative, under 35 U.S.C. §103(a) over U.S. Patent Application Publication No. 2004/0058266 to Matsumura et al. The Office Action also rejects claims 1-21 under 35 U.S.C. §102(a) or, in the alternative, under 35 U.S.C. §103(a) over U.S. Patent No. 4,217,406 to Tanaka et al. Applicants respectfully traverse these rejections with respect to claims 1, 8, 9, 11, 12 and 14-21, claims 2-7, 10 and 13 having been canceled.

Independent claims 1 and 17 each set forth, in pertinent part, a toner composition that comprises "at least one thermally cross-linkable polymer resin and at least one cross-linking agent, wherein: ... the at least one cross-linking agent is at least one member selected from the group consisting of polyfunctional amine catalysts." Claims 8, 9, 11, 12, 14-16, 20 and 21 depend from and include all of the limitations of claim 1; claims 18 and 19 depend from and include all of the limitations of claim 17.

As agreed in the February 1 personal interview, both Matsumura and Tanaka fail to teach or suggest toner compositions that include a polyfunctional amine catalyst as a cross-linking agent. Because neither cited reference teaches or suggests this feature of independent claims 1 and 17, neither Matsumura nor Tanaka can anticipate or render obvious the subject matter of independent claims 1-17 and their dependent claims.

Accordingly, reconsideration and withdrawal of the rejections are respectfully requested.

### III. Conclusion

In view of the foregoing, it is respectfully submitted that this application is in condition for allowance. Favorable reconsideration and prompt allowance of claims 1, 8, 9, 11, 12 and 14-21 are earnestly solicited.

Should the Examiner believe that anything further would be desirable in order to place this application in even better condition for allowance, the Examiner is invited to contact the undersigned at the telephone number set forth below.

Respectfully submitted,



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Date: March 3, 2006

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